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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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LANXESS CORPORATION
111 RIDC PARK WEST DRIVE
PITTSBURGH, PA 15275-1112

EXAMINER	
MULCAHY, PETER D	

ART UNIT	PAPER NUMBER
1796	

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08/24/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/825,934	MUSCH ET AL.	
	Examiner	Art Unit	
	Peter D. Mulcahy	1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 June 2010*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3 and 5-25* is/are pending in the application.

4a) Of the above claim(s) *8-25* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3 and 5-7* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-3 and 5-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. The claim language "significant" remains indefinite. This is a relative term and is undefined in the specification. Further, example 3 which is based on dispersion D, and is an inventive example, reports an initial pH of 12.8 and a pH after heat aging of 9.6. This is a drop in pH of 3.2. This would appear to be a "significant" drop in pH. As such it is unclear as to how this term further limits the claim.

4. Applicant respond to this rejection by stating that the specification, at Table 2(a), describes the term with sufficient specificity so as to provide one having ordinary skill in the art an understanding of the scope. This is not persuasive. The question here is the run identified as Example 3 from dispersion D. It is unclear as to whether or not this is representative of the invention. If so, the 3.2 drop in pH appears significant. Applicant has failed to address this in the response.

5. The claims are further unclear in the reference to "storing" and "storage." Claim 1 step b) recites "subsequently storing the dispersion" and further "drop in pH after storage." The claims are indefinite in that one cannot ascertain if the "storing" and "storage" are to be one in the same or two different steps. The record would support the

interpretation as these being different steps and/or time periods. Step b) in the claim equates to a heat aging step as taught in the art. This step is complete at the point at which the change in gel content is obtained. The "after storage" time period is understood to be subsequent to the heat aging step b) and prior to end use.

6. Applicant responds to this rejection by stating that "storing" is defined at page 7, lines 24-29 and that "storage" is defined at Table 2 (a). This Is not seen to be the case. The relevant portion of the specification,

> **storage** of the dispersion at temperatures of 50°C - 110°C, preferably 60°C - 90°C, particularly preferably 70°C - 90°C, the content which is insoluble in organic solvents (gel content) rising by at least 10% to 1 wt.% -60 wt.%

shows that "**storing**" in not defined, described or mentioned in this portion of the specification. This supports the indefiniteness of the claim in that applicants are using these two terms interchangeably, to have the same meaning and different meanings. It appears the "storage" step described at this portion of the specification and claimed as "b) subsequently storing" is actually the "conditioning" step described at page 15 line 1 of the specification.

7. Further, while "storage" is defined at table 2a, it is defined differently at page 7 of the specification. Clarification is required.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –

> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 1-3 and 5-7 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Youker US 3,639,301 or EP 451 998 or JP 2001-049043.

10. The rejections set forth under 35 USC 102/103 in the paper mailed 12/8/09 are deemed proper and are herein repeated.

11. Applicants remarks and the declaration filed in response to this rejection have been fully considered but have been found not persuasive.

12. Again, the claims are directed to a dispersion or a product. The patentability of the product is determined by the product limitations. Applicant continues to argue the process limitations of the claim as distinguishing features. This is not persuasive or relevant as to the patentability of the claimed dispersion. The significant claim limitations relative to the dispersion product are the gel content being 1-60% and the "aqueous polychloroprene dispersion… wherein the aqueous polymer dispersion does not have a significant drop in pH after storage." It is maintained that any dispersion that meets these limitations anticipates the claims under 35 USC 102/103. It is well

established that claims are properly rejected under 35 USC 102/103 when the reference teaches a product that appears to be the same as, or an obvious variant of, the product set forth in a product-by-process claim although produced by a different process. *See In re Marosi, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983) and In re Thorpe, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985). See also MPEP § 2113.*

13. Youker prepares the chloroprene dispersion following the procedure shown in Wilder US 2,405,724. This patent polymerizes at 40°C. This is compared to the claimed process limitation of 25°C. The pH at polymerization is reported as being 12.3 in column 3 lines 16 and 20. The pH is lowered by the heat aging but the pH does not have a "significant" drop in pH after storage, see column 2 lines 39-50. Here the stability is discussed. It is understood that the gel content is low given the teaching that the latex will not be in danger of gelation prior to its intended use. It is reasonable to presume that the product in the art necessarily posses properties that anticipate and/or render obvious the claimed product.

14. The declaration has been fully considered but fails to obviate the rejection. It is unclear that the 3.1 drop in pH is significant given that the examples show inventive runs having a drop in pH greater than that shown. It is further unclear that the "storage" conditions are the same. It should be noted that the "storage" limitation as claimed is not limited by the specification. The fact that applicant can show that the dispersion of example 3 in Yourker has different properties, does not mean that the claimed dispersion is patentably distinct. The dispersion of Yourker anticipates the claims during storage at the point at which the pH has no significant drop.

15. Applicant has misunderstood the rejections relative EP 451 998 and JP- 2001-049043. These rejections are under 102/103 and the rationale is the same as applied to Yourker. Specifically, it is well established that claims are properly rejected under 35 USC 102/103 when the reference teaches a product that appears to be the same as, or an obvious variant of, the product set forth in a product-by-process claim although produced by a different process. *See In re Marosi, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983) and In re Thorpe, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985). See also MPEP § 2113.*

16. Applicant has failed to respond to the 102/103 nature of the rejection. Applicant has responded to a 103 rejection arguing that the process limitations are not taught in the references. This is not persuasive. The alleged non-obviousness of the process limitations claimed relative to the claimed process limitations are not germane to the patentability of the claimed invention.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter D. Mulcahy whose telephone number is 571-272-1107. The examiner can normally be reached on Mon.-Fri. 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Peter D. Mulcahy/
Primary Examiner, Art Unit 1796